

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/488, 107 01/20/00 FRISS

W 23616.01

TM02/0131

EXAMINER

R Lewis Gable  
Cowan Liebowitz & Latman PC  
1133 Avenue of the Americas  
New York NY 10036-6799

PATEL, J

ART UNIT	PAPER NUMBER
----------	--------------

2164

DATE MAILED: 01/31/01 6

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**Application No.  
**09/488,107**

Applicant(s)

**Friss et al**

Examiner

**Jagdish Patel**

Group Art Unit

**2164** Responsive to communication(s) filed on Jan 20, 2000. This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims** Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

 Claim(s) \_\_\_\_\_ is/are allowed. Claim(s) 1-32 is/are rejected. Claim(s) \_\_\_\_\_ is/are objected to. Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers** See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner. The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119** Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All  Some\*  None of the CERTIFIED copies of the priority documents have been received. received in Application No. (Series Code/Serial Number) \_\_\_\_\_. received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)** Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). 2,3 Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152**-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --**

Art Unit: 2164

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 preamble recites it as “a method of operating a programmed computer for offering...” . None of the method steps pertain to operating a programmed computer. No connection is evident from the claim limitations which method steps are to be performed on the computer.

Claim 1 is further rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Steps a) “offering for sale...” and b) “receiving orders from prospective purchasers..” do not correlate because there is no limitation reciting communication of the offers in the step “offering for sale...of one or more selected collectibles” to the prospective purchasers.

Furthermore, since the “programmed computer” is operated in conjunction with a primary market and a secondary market, it is unclear how the stated objective of “offering for sale collectibles on a primary market and a secondary market..” is realized without communicating the

Art Unit: 2164

offerings amongst the “prospective purchasers”, “successful purchasers” in a primary market and also between the “certain of said purchasers” and purchasers of the offerings in the secondary market.

Dependent claims 2-19 inherit the deficiencies of parent claim 1.

3. Claims 20-27 recite the limitation "the successful purchasers" in line 15 step d) and e) of parent claim 20. There is insufficient antecedent basis for this limitation in the claim.

Additionally, whereas the preamble defines the claimed invention as “a method of preparing a server to support a plurality of purchaser systems.”, there is no reference in claim limitations of purchaser system(s). Claim 20, additionally, fails to clearly recite relationship of the “Purchaser systems” of primary markets, those of secondary markets and the server which is prepared to facilitate the offerings.

Dependent claims 21-27 inherit the deficiencies of parent claim 20.

4. Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

means for purchasers to place orders during the first offering for sale (see explanation below).

Claim 28 recites the limitation “a purchaser history database .....for purchaser that places orders...”. There is insufficient antecedent basis for this limitation in the claim because the claimed invention has no means to enable a purchaser to place order during the first offering for sale.

Art Unit: 2164

Claim 29 recites “..said record of the identified purchaser”. However, no means recited which identify a purchaser.

Claim 30-32 recite “..the successful ones of the purchasers..who transmitted orders...”. There is insufficient antecedent basis for this limitation.

5. Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 preamble recites “a server designed to support a plurality of purchaser systems to transmit over the Internet to said server orders for selected collectibles being offered for sale....” However, the claimed invention merely recite limitations (part of structure of the product claimed) which include means for “a first offering for sale...”, a “second offering for sale..” and a “purchase history database...”. No limitations recited which would particularly point out and distinctly claim limitation pertaining to a plurality of purchaser systems as defined in the preamble.

Dependent claims 29-32 inherit deficiency of the parent claim 28.

#### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2164

7. Claims 1-5, 7-9, 13,14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obrien et al. ("An Introduction to the Collectible Sportscard Market", Managerial Finance 1995, vol. 21 No.6) and further in view of Woolson (US Pat. 5,845,265).

Obrien et al. teach method of offering collectibles on a primary and on a secondary market comprising :

a) offering for sale an initial placement of one or more selected collectibles on a primary market (p. 51 B. *Primary Market Activity*, here the reference teaches that manufacturers offers collectibles (sportscards) to investor/speculators (primary market buyers)..);

b) receiving orders from prospective buyers orders on selected of the collectibles and allocating the selected collectibles to certain successful purchasers (p. 53 second para. 4 Limited Production: "The Topps company announced that...., and only enough cards would be produced ...to meet the advanced orders of dealers...");

c) offering for sale at the direction of certain of the purchasers selected of the collectibles on a secondary market (p. 49-50 description under titled A. *Secondary Market Activity*: 1.Dealer Activity..last three para.s).

Obrien fails to teach computer implementaion of the claimed method as claimed.

Woolston, in the same field of endeavor, however, teaches a method of operating a computerized market for collectibles (abstract and col. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the Obrien method of sale of collectibles in primary and secondary market. The motivations for the combination are that computer implementaion would allow the operator of the computer to act as a broker (or

Art Unit: 2164

investor/speculator) having access to means to electronically present the collectibles to an electronic market (secondary market) while allowing the investors/speculators to buy collectibles in primary market (for example, the operator of a consignment node in Woolston reference acting as a investor/speculator).

Claim 2: the step of limiting number of collectibles of one kind to be offered for sale on said primary market (para 3. P. 52 “..special limited production..”, para 4. “Limited Production” p.53).

Claim 3: collectibles comprise trading cards (abstract).

Claim 4: offering for sale on the primary market is carried out for a first selected, predetermined period of time (refer to para 4. “Limited Production” p.53).

Claim 5: offering for sale on the secondary market is carried out for a second selected period of time (the second period of time is when the dealer who bought collectibles from distributors and manufacturers on the primary market (p.50 l-2) sells at sportscard shows held seasonally as recited in section III.A.1 :Dealer Activity).

Claim 7-9: further including the step of predetermining said number of collectibles to be offered for sale on said primary market before the step of offering for sale on said step of offering..on said primary market, allocating counts the number of collectibles for which orders have been placed, compares said number of counted collectibles with said predetermined number of collectibles (..only enough cards would be produced in 1992 to meet the advanced orders of dealers, which were few (p.53 para titled 4. Limited production..).

Art Unit: 2164

Claim 13 and 14: step of providing lots of the collectibles for offering for sale on said primary market (... cases of cards..practice of distributing boxed factory sets..p. 51 section B. "Primary Market Activity").

Claim 15: Obrien fails to teach the step of enabling the successful purchasers of collectibles on said primary market to have an offering for sale administrator hold their purchased collectibles in escrow. Woolston, however teaches that a method of offering collectibles for sale wherein the successful purchasers of collectibles on a primary market may use a sale administrator hold their purchased collectibles ("collectible goods") in escrow. ("trusted means" to assure good's bona fide availability and title) an offering for sale administrator hold their purchased collectibles in escrow (Woolston, col. 3 L 36-41).

It would have been obvious to implement a step of allow the purchasers of collectibles in the primary market to elect to have an offering for sale (a trusted third party) to hold their purchased collectibles in escrow as claimed because the purchaser would not incur risk or expense associated with shipping and safekeeping the possession and would facilitate quick selling of the purchased collectible in a secondary market.

Claim 17 and 18: each of said purchaser's orders in step b) includes a number of collectibles wanted by the purchaser ("advanced orders" of dealers O'Brien, p. 53 second para. Titled "Limited Production"). Predefining the number of collectibles before carrying out..offering for sale is also met because the advanced orders inherently specifies number of collectibles from each purchaser.

Art Unit: 2164

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 20, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Woolston (US Pat. 5,845,265).

Regarding claim 20: Woolson recites a method of preparing a server to support a plurality of purchaser systems to transmit over the Internet orders for collectibles being offered for sale on a primary market and a secondary market (col. 1 L 42-48 “double tier” computerized market, col. 7 “computer implementation” L 50-67), said method comprising the steps of:

- a) constructing at the server a purchaser history database (col. 12 L 33-36);
- b) offering for sale an initial placement of a number of selected collectibles on a primary market (col. 2 L 19-67, refer to “It is ..a central market maker computer may be divided into different markets..);
- c) creating at least an account in purchaser history database for each purchaser...each account including a record of the purchasing activity of its purchaser (col. 7 L 24-30 and col. 12 L 33-36);
- d) allocating said selected collectibles to (the) successful purchasers (col.25-41, “take electronic ownership of good..); and

Art Unit: 2164

e) offering for sale at direction of certain of the successful purchasers selected of said allocated collectibles on a secondary market (col.25-41, ..post new participant defined offer.. (secondary market) ).

Claim 28: Woolston discloses a server designed to support a plurality of purchaser systems to transmit over the Internet to said server orders for selected collectibles being offered for sale on a primary market and a secondary market (col. 3 L 1-7), said server comprising:

a) a programmed server engine that implements first offerings for sale of an initial placement of collectibles on a primary market and a second offering for sale on a secondary market of the collectibles purchased during said first offering of sale (first offering of ...on a primarket (a participant electronically purchases collectibles from a consignment node , second offering for sale is “post a new participant defined offer” in the secondary market as claimed (col. 3 L 25-41);

b) a purchaser history database that keeps a record for each purchaser that places orders at least during said first offering of sale (col. 7 L 24-30 and col. 12 L 33-36).

Claim 29: server responds to each order received from an identifiable purchaser to update said record of the identifiable purchaser (col. 12 L 33-36).

*Prior Art Cited*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2164

*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JNP 01/26/01



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100